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Gerhard Wennerstrom

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EXAMINER

BUI, KIEU OANH T

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/963,598	Applicant(s) WENNERSTROM ET AL.	
	Examiner KIEU-OANH BUI	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11-21,23-26 and 28-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 11-21, 23-26, 28-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. Claims 2, 10, 22, and 27 have been cancelled, and claims 30-33 have been previously added. Pending claims for reconsideration are claims 1, 3-9, 11-21, 23-26, and 28-33.

Response to Arguments

2. Applicant's arguments filed on 02/28/2008 have been fully considered but they are not persuasive.

Applicants basically argue that firstly claims 9 and 33 recites about “earmarked” and McGarraham does not teach or suggest that; however, the examiner respectfully disagrees because “earmarked” by the dictionary, it has a simple meaning as:

earmark

Verb

to set (something) aside for a specific purpose

Noun

a feature that enables the nature of something to be identified: *it had all the earmarks of a disaster*

On pages 3-4/par. 0038, McGarraham uses “tags” (or tagged) for identifying the tagged content and the corresponding advertisements (or trailers); therefore, the tagging of McGarraham can be regarded as “earmarked” for marking a feature that the trailer or the advertisement will be displayed correspondingly to the content which the user is interested to view.

Secondly, the issue that the applicants argue about a secondary program file which the user can not select for display since the ads is on schedule; however, McGarraham does not limit the secondary file as an advertisement, it can be a trailer or preview (page 4/1st paragraph) and then later on page 5/par. 0049, the GUI provides the user to control and select a preview for display and/or select or delete any of the cached content from the hard disk.

Finally, the arguments of the applicants seem to be self contradicted themselves because the applicants tend to argue that the secondary program data file is not a movie trailer or an advertisement (although applicants does not state so) by observing their arguments on page 10, 1st and 2nd paragraph. Applicants quote that “McGarrahan’s advertisements and trailers are played only according to a predetermined schedule based on the primary program requested...” and “... McGarrahan does not disclose receiving at approximately the same time primary program data and associated secondary data ...” and states that claim 1, 16, 28 and 32 directed to similar features are not anticipated by McGarrahan. However, looking back at the specifications on page 5, from lines 14-22, the secondary program data is clearly a promotional material, namely, a preview or trailer of the movie; and of course, the trailer or preview needs to be display either at the beginning, at the end or when the viewer is paused. Then, the examiner does not see or realize any special feature that the preview or trailer of the applicants’ application is novel than the preview or trailer of McGarrahan’s, and now the examiner would raise a same question back to the applicants that it would not make sense as their trailer would display at the same time with the primary data (movie) as presently claiming for. Obviously, there must be a mistake therein as the applicants aim to a different path (as in claim languages) while does the same as McGarrahan's. For the low resolution issue, refer back again to Claim 5.

Therefore, the examiner stands with the rejection as previously disclosed, not limited to the cited paragraphs from the examiner but also to the entire disclosure of McGarrahan’s, and now discussed herein.

Claim Rejections - 35 USC 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

4. Claim 1, 3-9, 11-21, 23-26, and 28-33 are rejected under 35 U.S.C. 102(e) as being anticipated by McGarrah et al. (U.S. Patent Pub No. 2003/0026424 A1).

Regarding claim 1, McGarrah discloses a client multimedia apparatus comprising a receiver to receive at approximately the same time primary program data and associated secondary program data from a communication channel, a data storage medium and a data processor operable to record the primary program data and the associated secondary program data on the data storage medium as separated files (Fig. 2 for the client multimedia apparatus or multisource multimedia transmitter receiver player, namely a set top box 124 with the hard drive and further details on Fig. 5 for storage device 511 for storing primary data and associated secondary program data, i.e, advertisements or commercials, page 4/par. 0042 and page 5/par. 0048 for associated secondary data as ads and trailers related to the primary data; since advertisements or trailers are cached to the set top box for displaying to the users, yet at the end of the movies or at the beginning or pop up whenever the movies is paused; then it suggests that the ads or trailers are stored as separate files from the main program); the data processor, subsequent to the storage of the primary data and its associated secondary data being completed,

provide a user interface for selection of the program data files and retrieve a secondary program data file selected by a viewer for display (Fig. 5 and page 8/par. 0083- to page 9/par. 0090 for details on data processor 505, user interfaces such as input devices 515, cursor control 517 with display 513).

(Claim 2 has been cancelled.)

As for claim 3, McGarrahan further discloses wherein the secondary program data comprises promotional material selected from the group comprising forms: audio, video, pictures, text and graphics (page 5/par. 0048 for ads and trailers where they are parts or preview of the main program including all forms not limited to audio or video).

As for claim 4, McGarrahan further discloses wherein the primary program and secondary program data are in the form of MPEG-2 files (page 2-3, par. 0028 & 0029).

As for claim 5, McGarrahan further discloses wherein the secondary program data is of a lower resolution than that of the primary program data (page 3/par. 0032-0033 **as the contents can be delivered in standard or conventional formats for ads or trailers as known in the art, and the program can be in high resolution standards as MPEG 2 or MPEG 4 video for better quality – page 5/par. 0046).**

As for claim 6, McGarrahan teaches this feature for allowing marking of the primary program data for deletion or prolonged keeping upon user input during display of the secondary data (page 5-6, par. 0056-0057 as the user controls the deletion of programs that they do not want to keep).

As for claim 7, McGarrahan further teaches a set top box comprising a multimedia apparatus as cited in claim 1 (Fig. 5 and page 8-9, par. 0083 to par. 0090).

As for claim 8, McGarranhan further teaches including a display device for displaying the primary and secondary data received from the storage medium (Fig. 1 with a display device 122 or at laptop screen 126).

Regarding claims 9, 11-15, and 28-29, these claims are rejected for the reasons given in the scope of claims 1, and 3-8 above, with additional features of computer processing of identifying the copy portions of primary program data that has been earmarked and stored a copy of said earmarked data as an associated secondary program data for subsequently provide a user interface for selection of the stored data files and retrieve a secondary program file accordingly selected by a viewer for display, wherein the primary program data and the secondary program data are stored in separated files (page 5/par. 0048 since advertisements or trailers are cached to the set top box for displaying to the users, yet at the end of the movies or at the beginning or pop up whenever the movies is paused; then it suggests that the ads or trailers are separate files from the main program **and the “earmarked” issue as discussed in the argument above**).

As for claims 16-21, and 23-26, these method claims with same limitations addressed earlier are rejected for the reasons given in the scope of claims 1, and 3-8.

As for claim 30, McGraranhan shows a list of recorded or stored contents from broadcast contents including main programs and ads or trailers (page 4/par. 0044 & page 5/par. 0047-0048 again).

As for claims 31-33, McGarranhan further teaches “the secondary programming data provides a trailer for the primary program data” (page 5/par. 0048); **and the “earmarked” issue as discussed in the argument above**.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to PTO New Central Fax number:

(571) 273-8300, (for Technology Center 2600 only)

*Hand deliveries must be made to Customer Service Window,
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner can normally be reached on Monday-Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller, can be reached at (571) 272-7353.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/KIEU-OANH BUI/
Primary Examiner, Art Unit 2623